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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/685,583

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

MICHAEL R. ZECHER

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-38 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8500)  
Paper No(s)/Mail Date 10/16/2003, 1/18/2005, 12/7/2006, 2/26/2007  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_



### DETAILED ACTION

1. The following is a first, non-final Office Action on the merits. **Claims 1-38** are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-38** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. **Claims 1 & 24** recite the limitation "method/system for enabling online banking" in the preamble of these claims. It is not clear how the objective of online banking is performed by implementing the steps of the claim. The last limitation "identifying, in the computer system and from the data regarding the identity of the banking customer and the identity of the form, a banking transaction" does not guarantee that the online banking transaction is actually performed. In fact the phrase "online" or its equivalent is not even mentioned in the body of the claim. Hence the scope of the claims remains unclear.

**Claims 2-23** depend from claim 1 and therefore contain the same deficiency.

**Claims 25-38** depend from claim 24 and therefore contain the same deficiency.

5. **Claims 1, 2, 3, 6, 8, 11, 19, 24, 26, & 33** recite a "sensing device". This recitation interpreted in its broadest sense could mean any sensing device such as a barcode scanner. Applicant's Specification recites "optically imaging pen" on page 11, line 26.

6. **As per claims 18 & 34**, various "means for" are claimed, but there is no support for their corresponding structure in the specification, as required by § 112, 6th paragraph. The Examiner requests Applicant to either particularly point out the corresponding structures in the specification or remove the "means for" language.

**Claim 19** depends from claim 18 and therefore contains the same deficiency.

**Claims 35 & 38** depend from claim 34 and therefore contain the same deficiency.

7. The preamble of **claim 1** recites "A method of enabling online banking ....". "Enabling" is not a positive recitation. The preamble would be better recited as "A method of online banking ....".

**Claim 24** contains the same deficiency.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-38** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 1-38** are drawn to a method and system for performing online banking and printing the form on demand. It is unclear how the objective of online banking by the Applicants' is achieved in the claims. In fact, "online" or even its equivalent is not mentioned in the body of claims 1 and 24. As such the claimed invention is directed to a judicial exception under 35 U.S.C. §101 (i.e. an abstract idea, natural Phenomenon, or law of nature) and is not directed to a practical application of such judicial exception

because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

**Useful-** must be specific, substantial and credible and specifically recited in the claim. If the claim is broad enough to not require a practical application, it must be rejected.

**Tangible-** must be some "real-world" result, not abstract.

**Concrete** - must have a result that can be substantially repeatable or the process must substantially produce the same result again. Claim 1 does not produce tangible results, but merely determinations. These determinations might remain entirely inside the mind of the person doing the determining. These results are not tangible and are rejected.

Similarly printing a banking form on demand does not produce a real-world result unless further action is taken. Movement of the sensing device relative to the form also fails to produce a real world-result without further action. The parameter being an action parameter is mentioned in claim 4. Furthermore, Claims 1-38 do not necessarily affect the physical world. They lack a tangible and concrete result, and are rejected as non-statutory subject matter.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT & T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application.

That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the 101 judicial exception, which can be identified in various ways: (a) the claimed invention "transforms" an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107. The utility of at least one parameter relating to a banking transaction is unclear because there is no assurance that this will result in the performance of the online banking transaction.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application"). It is not clear as to what tangible result is produced by implementing the steps of the claim especially since there is no guarantee that implementing the steps of the claims will result in the performance of an online banking transaction.

For an invention to produce a "concrete" result the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862,864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" the claim

should be rejected under section 101). The opposite of "concrete" is Unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to



be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. **Claims 1-38** provisionally rejected on the ground of nonstatutory double patenting over **claims 1-34** of copending Application No. 10/685523 ("523"). This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

**As per claim 1**, 523 teaches a method of enabling online banking, the method including the steps of:

providing a banking customer with a form including coded data indicative of a identity of the form;

receiving, in a computer system, data from a sensing device regarding an identity of the banking customer and regarding the identity of the form, the sensing device containing the data regarding the identity of the banking customer and sensing the data regarding the identity of the form using at least some of the coded data; and

identifying, in the computer system and from the data regarding the identity of the banking customer and the identity of the form, a banking transaction (See claims 1 & 19).

**As per claim 2**, 523 teaches the coded data is also indicative of at least one parameter of the banking transaction, and the method includes receiving, in the computer system, indicating data from the sensing device regarding said at least one parameter of the banking transaction, the sensing device sensing the indicating data using at least some of the coded data (See claim 1).

**As per claim 3**, 523 teaches receiving, in the computer system, data from the sensing device regarding movement of the sensing device relative to the form, the sensing device generating data regarding its own movement relative to the form (See claim 1).

**As per claim 4**, 523 teaches the parameter is an action parameter of the banking transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (See claim 2).

**As per claim 5**, 523, teaches the action parameter of the banking transaction is selected from the group comprising:

a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments (See claim 3).

**As per claim 6**, 523 teaches the parameter is an option parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (See claim 4).

**As per claim 7**, 523 teaches the option parameter is associated with at least one of:

a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name (Claim 5).

**As per claim 8**, 523 teaches the parameter is a text parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter (See claim 6).

**As per claim 9**, 523 teaches converting, in the computer system, the handwritten text data to computer text (See claim 7).

**As per claim 10**, 523 teaches the text parameter is associated with at least one of:

a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a payment date, and a check number (See claim 8).

**As per claim 11**, 523 teaches the parameter is an authorization parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter (See claim 9) .

**As per claim 12**, 523 teaches verifying, in the computer system, that the signature is that of the customer (See claim 10).

**As per claim 13**, 523 teaches the authorization parameter is associated with authorization for at least one of:

access to account information, withdrawal of funds; transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks (See claim 11).

**As per claim 14**, 523 teaches the parameter is a picture parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a hand-drawn picture by means of the sensing device and effecting, in the computer system, an operation associated with the picture parameter (See claim 12).

**As per claim 15**, 523 teaches the picture parameter is associated with a graphic design for a customer's checks (See claim 13).

**As per claim 16**, 523 teaches the form contains information relating to at least one of:

information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments (See claim 14).

**As per claim 17**, 523 teaches printing the form on demand (See claim 15).

**As per claim 18**, 523 teaches printing the form on a surface of a surface-defining means and, at the same time that the form is printed, printing the coded data on the surface (See claim 16).

**As per claim 19**, 523 teaches printing the coded data to be substantially invisible in the visible spectrum (See claim 17).

**As per claim 20**, 523 teaches retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (See pg. 21 of the specification).

**As per claim 21**, 523 teaches distributing a plurality of forms using a mixture of multicast and pointcast communications protocols (See claim 18).

**As per claim 22**, 523 teaches providing all required information relating to the banking transaction in the form to eliminate the need for a separate display device (See Figures 4, 8, & 11 and col. 13, line 20 through col. 16, line 55).

**As per claim 23**, 523 teaches the form is printed on multiple pages and in which the method includes binding the pages (See claim 21).

**Claim 24** recites equivalent limitations to claim 1 and is therefore rejected using the same art and rationale set forth above.

**Claims 25-28** recite equivalent limitations to claims 2-5, respectively, and are therefore rejected using the same art and rationale set forth above.

**Claim 29** recites equivalent limitations to claim 7 and is therefore rejected using the same art and rationale set forth above.

**Claim 30** recites equivalent limitations to claim 10 and is therefore rejected using the same art and rationale set forth above.

**Claim 31** recites equivalent limitations to claim 13 and is therefore rejected using the same art and rationale set forth above.

**Claim 32** recites equivalent limitations to claim 15 and is therefore rejected using the same art and rationale set forth above.

**As per claim 33**, 523 teaches the sensing device includes a marking nib (See claim 29).

**Claims 34 & 35** recite equivalent limitations to claim 15 and are therefore rejected using the same art and rationale set forth above.

**Claims 36 & 37** recite equivalent limitations to claims 19 & 20, respectively, and are therefore rejected using the same art and rationale set forth above.

**Claim 38** recites equivalent limitation to claim 23 and is therefore rejected using the same art and rationale set forth above.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1-3, 6-13, 16, 20-26, 29-31, 33, & 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Jr. et al. (U.S. 5,797,002), and further in view of Richards et al. (U.S. 6,539,361).

**As per claim 1**, Patterson, Jr. et al. teaches a method of enabling online banking, the method including the steps of:

providing a banking customer with a form including coded data indicative of a identity of the form;

receiving, in a computer system, data from a sensing device regarding an identity of the banking customer and regarding the identity of the form, the sensing device containing the data regarding the identity of the banking customer and sensing the data regarding the identity of the form using at least some of the coded data (See col. 13, line 20 through col. 16, line 55).

However, Patterson Jr. et al. does not disclose identifying, in the computer system and from the data regarding the identity of the banking customer and the identity of the form, a banking transaction.

Richards et al. discloses a method of automated banking (See abstract).

Both Patterson Jr. et al. and Richardson et al. provide a means for conducting a financial transaction. Richards et al. discloses both a banking customer and a financial transaction in a banking system (See col. 1, lines 16-44 and col. 2, line 67 through col. 3, line 54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patterson Jr. et al. to include identifying both a banking customer and a banking transaction as taught by Richardson et al. in order to allow banking customer to benefit from using quick and efficient forms for financial transactions.

**As per claim 2**, Patterson Jr. et al. teaches the coded data is also indicative of at least one parameter of the banking transaction, and the method includes receiving, in the computer system, indicating data from the sensing device regarding said at least one parameter of the banking transaction, the sensing device sensing the indicating data using at least some of the coded data (See col. 13, line 20 through col. 16, line 55).

**As per claim 3**, Patterson Jr. et al. teaches receiving, in the computer system, data from the sensing device regarding movement of the sensing device relative to the form, the sensing device generating data regarding its own movement relative to the form (See col. 13, line 20 through col. 16, line 55).



**As per claim 6**, Patterson Jr. et al. does not disclose the parameter is an option parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a hand-drawn mark by means of the sensing device and affecting, in the computer system, an operation associated with the option parameter.

Richards et al. discloses allowing a banking customer to access and annotate financial documents (See col. 30, line 65 through col. 31, line 39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patterson Jr. et al. to include an option parameter in a banking transaction that allows a user to access and annotate documents as taught by Richards et al. in order to allow banking customer to quickly and efficiently access and process documents concerning financial transactions.

**As per claim 7**, Patterson Jr. et al. does not disclose the option parameter is associated with at least one of:

a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name.

Richards et al. discloses enabling customers to dispensing cash, make deposits, transfer funds, etc. (See col. 1, lines 26-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patterson Jr.

et al. to include an option parameter in a banking transaction comprising a request for dispensing cash, making deposits, transferring funds, etc. as taught by Richards et al. in order to allow banking customer to benefit from using quick and efficient means for processing financial transactions.

**As per claim 8**, Patterson Jr. et al. teaches the parameter is a text parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter (See Figures 4, 8, & 11 and col. 13, line 20 through col. 15, line 55).

**As per claim 9**, Patterson Jr. et al. teaches converting, in the computer system, the handwritten text data to computer text (See Figures 4, 8, & 11 and col. 13, line 20 through col. 15, line 55).

**As per claim 10**, Patterson Jr. et al. teaches the text parameter is associated with at least one of:

a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a payment date, and a check number (See Figures 4, 8, & 11 and col. 13, line 20 through col. 15, line 55; and, furthermore, these parameters are inherently part of processing and/or writing checks).

**As per claim 11**, Patterson Jr. et al. teaches the parameter is an authorization parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the

authorization parameter (See Figures 4, 8, & 11 and col. 13, line 20 through col. 15, line 55).

**As per claim 12**, Patterson Jr. et al. teaches verifying, in the computer system, that the signature is that of the customer (See Figures 4, 8, & 11 and col. 13, line 20 through col. 15, line 55; and, furthermore, verifying a signature is inherent when processing a check).

**As per claim 13**, Patterson Jr. et al. does not disclose the authorization parameter is associated with authorization for at least one of:

access to account information, withdrawal of funds; transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks.

Richards et al. discloses enabling customers to dispensing cash, make deposits, transfer funds, etc. (See col. 1, lines 26-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patterson Jr. et al. to include an authorization parameter in a banking transaction comprising a request for dispensing cash, making deposits, transferring funds, etc. as taught by Richards et al. in order to allow banking customer to benefit from using quick and efficient means for processing financial transactions.

**As per claim 16**, Patterson Jr. et al. teaches the form contains information relating to at least one of:

information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an

account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments (See Figures 4, 8, & 11 and col. 13, line 20 through col. 16, line 55).

**As per claim 20**, Patterson Jr. et al. teaches retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (See col. 8, line 32 through col. 9, line 2).

**As per claim 21**, Patterson Jr. et al. teaches distributing a plurality of forms using a mixture of multicast and pointcast communications protocols (See col. 19, lines 11-27 and col. 23, lines 44-47).

**As per claim 22**, Patterson Jr. et al. teaches providing all required information relating to the banking transaction in the form to eliminate the need for a separate display device (See Figures 4, 8, & 11 and col.13, line 20 – col.16, line 55).

**As per claim 23**, Patterson Jr. et al. teaches the form is printed on multiple pages and in which the method includes binding the pages (See Figures 4, 8, & 11 and col. 13, line 20, through col. 16, line 55).

**Claim 24** recites equivalent limitations to claim 1 and is therefore rejected using the same art and rationale set forth above.

**Claims 25 & 26** recite equivalent limitations to claims 2 & 3, respectively, and are therefore rejected using the same art and rationale set forth above.

**Claim 29** recites equivalent limitations to claim 7 and is therefore rejected using the same art and rationale set forth above.

**Claim 30** recites equivalent limitations to claim 10 and is therefore rejected using the same art and rationale set forth above.

**Claim 31** recites equivalent limitations to claim 13 and is therefore rejected using the same art and rationale set forth above.

**As per claim 33**, Patterson Jr. et al. teaches the sensing device includes a marking nib (See col. 8, line 52 through col. 9, line 12).

**Claim 37** recites equivalent limitations to claim 20 and is therefore rejected using the same art and rationale set forth above.

14. **Claims 4, 5, 27, & 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Jr. et al. (U.S. 5,797,002), in view of Richards et al. (U.S. 6,539,361), and further in view of Dymetman et al. (U.S. 6,330,976).

**As per claim 4**, the Patterson Jr. et al. and Richards et al. combination does not disclose the parameter is an action parameter of the banking transaction, the method including effecting, in the computer system, an operation in respect of the action parameter.

Dymetman et al. discloses a marking medium area with encoded identifier for producing action through a network (See abstract).

Patterson Jr. et al., Richardson et al., and Dymetman et al. provide a means for obtaining automatic action in a network (i.e. access to information). Dymetman et al. discloses an action parameter within the context of tracking a transaction in a network (See col. 4, lines 16-23). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Patterson Jr. et al. and

Richardson et al. combination to include an action parameter in a bank transaction as taught by Dymetman et al. in order to provide and process the necessary forms containing information relating to a financial transaction.

**As per claim 5**, Patterson Jr. et al. does not disclose the action parameter of the banking transaction is selected from the group comprising:

a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments.

Richards et al. discloses enabling customers to dispensing cash, make deposits, transfer funds, etc. (See col. 1, lines 26-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patterson Jr. et al. to include an action parameter in a banking transaction comprising a request for dispensing cash, making deposits, transferring funds, etc. as taught by Richards et al. in order to allow banking customer to benefit from using quick and efficient means for processing financial transactions.

**Claims 27 & 28** recite equivalent limitations to claims 4 & 5, respectively, and are therefore rejected using the same art and rationale set forth above.

15. **Claims 14, 15, 17-19, 32, 34-36, & 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Jr. et al. (U.S. 5,797,002), in view of Richards et al. (U.S. 6,539,361), and further in view of Official Notice.

**As per claim 14**, the Patterson Jr. et al. and Richards et al. combination does not disclose the parameter is a picture parameter of the banking transaction, the method including identifying, in the computer system, that the banking customer has entered a hand-drawn picture by means of the sensing device and effecting, in the computer system, an operation associated with the picture parameter.

The Examiner takes Official Notice that it is old and well known in the art to have picture parameters associated with a financial transaction that can be identified and associated with a particular operation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Patterson Jr. et al. and Richards et al. combination to include a picture parameter that may be identified and associated with an operation in order to timely identify a parameter and to minimize the necessary text required to identify an item or document.

**As per claim 15**, the Patterson Jr. et al. and Richards et al. combination does not disclose the picture parameter is associated with a graphic design for a customer's checks.

The Examiner takes Official Notice that it is old and well known in the art to have picture parameters associated with a financial transaction that can be identified and associated with a particular operation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Patterson Jr. et al. and Richards et al. combination to include a picture associated with a graphic design of a customer's check in order to timely identify a parameter and to minimize the necessary text required to identify an item or document.

**As per claim 17**, the Patterson Jr. et al. and Richards et al. combination does not disclose printing the form on demand.

The Examiner takes Official Notice that it is old and well known in the art to print forms on demand. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Patterson Jr. et al. and Richards et al. combination to include printing forms on demand in order to allow a banking customer access to paper records.

**As per claim 18**, the Patterson Jr. et al. and Richards et al. combination does not disclose printing the form on a surface of a surface-defining means and, at the same time that the form is printed, printing the coded data on the surface.

The Examiner takes Official Notice that it is old and well known in the art to print forms on demand and print coded data (i.e. checks). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Patterson Jr. et al. and Richards et al. combination to include printing forms on demand, including printing coded data, in order to allow a banking customer access to paper records and enhance security measures by coding relevant financial data.

**As per claim 19**, the Patterson Jr. et al. and Richards et al. combination does not disclose printing the coded data to be substantially invisible in the visible spectrum.

The Examiner takes Official Notice that it is old and well known in the art to print coded data to be substantially invisible (i.e. checks). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Patterson Jr. et al. and Richards et al. combination to include printing substantially



invisible coded data in order to enhance security measures by masking relevant financial data.

**Claim 32** recites equivalent limitations to claim 15 and is therefore rejected using the same art and rationale set forth above.

**Claims 34 & 35** recite equivalent limitations to claim 15 and are therefore rejected using the same art and rationale set forth above.

**Claim 36** recites equivalent limitations to claim 19 and is therefore rejected using the same art and rationale set forth above.

**Claim 38** recites equivalent limitation to claim 23 and is therefore rejected using the same art and rationale set forth above.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Silverbrook et al. (U.S. 7,406,445) discloses a method and system for banking.

Wellner (U.S. 5,640,193) discloses a multimedia service access by reading marks on an object.

Djuknic et al. (U.S. 6,964,374) discloses retrieval and manipulation of electronically stored information via pointers embedded in the associated printed material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. ZECHER whose telephone number is

(571)270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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